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EXAMINER
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANTHONY E. MARTINEZ and MICHAEL D. RAHN

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Appeal 2007-3276  
Application 09/981,877  
Technology Center 2100

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Decided: January 4, 2008

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Before JEAN R. HOMERE, JAY P. LUCAS, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-16. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM IN PART.

## THE INVENTION

The disclosed invention relates generally to previewing a graphical image corresponding to an icon in a clipboard (Spec. 1). More particularly, a preferred embodiment of Appellants' invention makes a determination, upon receiving a paste command, as to whether a plurality of objects are stored within the clipboard. If a plurality of objects are within the clipboard, the clipboard may be displayed with the icon associated with a last pasted object adjacent to the pointing device display position indicator. A preview instruction may result if a display position indicator is positioned over an icon displayed in the clipboard for a predetermined time. A reduced graphical image associated with the icon may be displayed in response to the icon preview instruction. Alternately, the icon may show a text symbol if the associated item stored on the clipboard contains only text (Spec. 4). If the icon selected represents text stored in the clipboard, the preview may include a text box showing a predetermined number of the text characters stored on the clipboard (Spec. 6).

Independent claims 1 and 4 are illustrative:

1. A method of previewing a graphical image corresponding to an icon in a clipboard, comprising:

receiving an icon preview instruction from a user; and

displaying the graphical image associated with the icon in response to the icon preview instruction.

4. A method of displaying a clipboard comprising:
  - receiving a paste command;
  - determining whether a plurality of objects are stored within the clipboard in response to the paste command; and
  - displaying the clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard.

#### THE EVIDENCE

The Examiner relies upon the following evidence in support of the rejection:

“Microsoft Word 2000,” Microsoft Corporation, computer program copyright 1999, screenshots made by the Examiner and labeled as “MS Figure 1” through “MS Figure 10.” (“Microsoft Word screenshots”).

#### THE REJECTION

Claims 1-16 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the Examiner’s Microsoft Word screenshots.

#### PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir.

1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (citations omitted).

## ISSUES

We decide whether Appellants have shown that the Examiner erred in holding that various screenshots of Microsoft Word anticipate the claimed subject matter.

More particularly, we have determined the following issues are dispositive in this appeal:

1. Whether Appellants have shown that the Examiner erred in applying various screenshots of Microsoft Word as evidence that the claimed invention was known or used by others in this country before the critical date.<sup>1</sup>
2. Whether Appellants have shown that the Examiner erred by broadly interpreting the claimed “graphical image associated with the icon” to read on text characters associated with an icon corresponding to a “drawing object or picture, or an item that doesn’t contain text,” as disclosed in the Microsoft Word

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<sup>1</sup> The instant application was filed on October 18, 2001.

screenshot labeled by the Examiner as “MS Figure 9.”<sup>2</sup> (*see* independent claims 1 and 9).

3. Whether Appellants have shown that the Examiner erred in reading the limitations of independent claims 4 and 12 on the proffered Microsoft Word screenshots.

### Issue 1

#### Admissibility of Computer Screenshots as Evidence

At the outset, we dismiss Appellants’ arguments directed to whether the Examiner’s Microsoft Word screenshots are a publication (*see* App. Br. 11-12). We find this issue moot because the Examiner does not rely on the Microsoft Word screenshots as a publication.

The Examiner clearly states in the Answer:

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<sup>2</sup> *See* the Microsoft Word screenshot labeled by the Examiner as “MS Figure 9,” in pertinent part:

**Tip** to view the first 50 characters of text in an item on the Office Clipboard, rest the mouse pointer on the item’s Icon. If the item is drawing object or picture, or an item that doesn’t contain text, Microsoft Word displays a label such as “Picture 2,” which indicates the order in which the item was copied. Note that the numbered labels of drawing objects and pictures indicate the copy order of drawing objects and pictures only; the numbered labels of items that don’t contain text indicate the copy order of all items.

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First, the Examiner has not stated, nor even alleged, that the documents were ever publicly accessible, much less accessible to persons concerned with the art to which the documents relate. The Examiner admits that the documents are screen shots of the Examiner's own computer taken April 22, 2004. Thus the earliest these documents could possibly have been publicly accessible is 2.5 years after the filing of this application.

(Ans. 11).

Instead, the Examiner contends that the 1983-1999 copyright date of the Microsoft Word 2000 program (as captured in the screenshot "MS Figure 8") is evidence that the features of Microsoft Word were *known and used* prior to the critical date of October 18, 2001 (Ans. 11-12).

We note that 35 U.S.C. § 102(a), in pertinent part, states that a person shall be entitled to a patent unless the invention was known or used by others in this country (before the critical date):

A person shall be entitled to a patent unless -

(a) *the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or*

(35 U.S.C. § 102(a), emphasis added).

We begin our analysis by noting that our reviewing court has previously considered computer screenshots as evidence. *See e.g., Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1362 (Fed Cir. 2001) ("However, as the screen shot plainly indicates, a purchaser could

use the display screen for purposes other than to order an electronic stock chart ( *e.g.*, to ‘ *L* ookup’ a stock symbol).”). We further note that the Board has previously considered Microsoft Word screenshots provided by an Examiner as evidence in *Ex parte Hendrickson*, 2004 WL 4981812 (BPAI, Oct. 29, 2004) (No. Appeal 2004-1003) and *Ex parte Keohane*, 2007 WL 375026 (BPAI, Jan. 31, 2007) (No. Appeal 2006-3121).<sup>3</sup>

Here, Appellants have focused their arguments on whether the Examiner’s screenshots are a publication (*see* App. Br. 11-12; Reply Br. 3). We find Appellants’ arguments misplaced. We find the copyright notice shown in the Examiner’s Microsoft Word screenshot<sup>4</sup> provides prima facie evidence that the features of the Microsoft Word computer program relied on by the Examiner were at least *known* in the United States in 1999. The 1999 date clearly antedates the October 18, 2001 filing date of the instant invention, and is thus “before the invention thereof by the applicant for patent,” as required by the language of 35 U.S.C. §102(a). Therefore, we consider the Microsoft Word screenshots made by the Examiner as admissible evidence to be considered under 35 U.S.C. § 102(a).

## Issue 2

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<sup>3</sup> Appeal Nos. 2004-1003 and 2006-3121 are publicly available at the Board’s FOIA web site: <http://des.uspto.gov/Foia/BPAIReadingRoom.jsp>

<sup>4</sup> *See* the Microsoft Word screenshot labeled by the Examiner as “MS Figure 8.”



We consider next the Examiner's rejection of independent claim 1 as being anticipated by the Examiner's Microsoft Word screenshots.

In particular, we consider the issue of whether Appellants have shown that the Examiner erred by broadly interpreting the claimed "graphical image associated with the icon" to read on text characters associated with an icon corresponding to a "drawing object or picture, or an item that doesn't contain text," as disclosed in the Microsoft Word screenshot labeled by the Examiner as "MS Figure 9."<sup>5</sup> (*see* independent claims 1 and 9).

Appellants contend that "[at] most, the 'reference' discloses that a *text* sample of the clipboard icon is disclosed upon a mouse action, and not the display of a *graphical* image." (App. Br. 9, emphasis in original; *see* the Microsoft Word screenshot labeled by the Examiner as "MS Figure 2").

The Examiner disagrees. The Examiner contends that "a box containing a graphical depiction of the text 'Picture 2'" meets the language of the claim (i.e., "displaying the graphical image associated with the icon") because text (i.e., fonts) are rendered as graphical images on the display.<sup>6</sup> (Ans. 9; *see also* the Examiner's Microsoft Word screenshot labeled as "MS Figure 9;" *see also* footnote 2 *supra*).

After considering the record before us, we find the evidence supports the Appellants' position. Appellants have argued that the Examiner has confused text with graphics (*see* Reply Br. 2). We agree. We acknowledge

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<sup>5</sup> *See* footnote 2 *supra*.

<sup>6</sup> *See also* Answer, p. 8, ¶1: "The examiner contends that when text is displayed on a display the text itself is a graphical image."

that text fonts are represented by bitmapped graphical images of characters, as argued by the Examiner (*see* Ans. 9). Nevertheless, we do not find the Examiner's broad reading of the claim to be a reasonable interpretation consistent with how a person of ordinary skill in the art would have interpreted the ordinary and customary meaning of the claim term "graphical image," as opposed to "text."<sup>7</sup> Therefore, we cannot sustain the Examiner's rejection of claim 1.

Because Appellants have established that the Examiner erred with respect to establishing a *prima facie* case of anticipation, we reverse the Examiner's rejection of independent claim 1 as being anticipated by the Microsoft Word screenshots. Because independent claim 9 recites the identical limitation of "displaying the graphical image associated with the icon," we also reverse the Examiner's rejection of claim 9. Because we have reversed the Examiner's rejection of independent claim 1, we also reverse the rejection of claims 2 and 3 that depend therefrom. Likewise, we reverse the Examiner's rejection of claims 10 and 11 that depend from independent claim 9.

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<sup>7</sup> Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enterprise Co. v. SRAM Corp.*, 336 F.3d 1298, 1302 (Fed. Cir. 2003). *See also In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) ("When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art.").

Issue 3

We consider next the Examiner's rejection of independent claims 4 and 12 as being anticipated by the Examiner's Microsoft Word screenshots.

In particular, we consider the issue of whether Appellants have shown that the Examiner erred in reading the limitations of independent claims 4 and 12 on the proffered Microsoft Word screenshots.

We begin our analysis by noting that Appellants have argued claims 1-3 and 9-11 as a single group (App. Br. 10, *see* last paragraph on page). Appellants have not directed arguments specifically to independent claims 4 and 12 in the Briefs. We note that independent claims 4 and 12 are directed to different limitations than the limitations recited in independent claims 1 and 9. In particular, the limitations that Appellants have argued render claim 1 patentable are not found within claim 4 or claim 12 (*see* discussion of claim 1 *supra*). The only arguments Appellants present for the patentability of independent claims 4 and 12 are the arguments contending that the Examiner's Microsoft Word screenshots are not references (i.e., not a publication) under 35 U.S.C. § 102(a), and thus cannot support an anticipation rejection (*see* App. Br. 11; *see* Reply Br. 3).

We have found *supra* that the Microsoft Word screenshots provide prima facie evidence that the features of the Microsoft Word computer program relied on by the Examiner were at least *known* in the United States prior to the critical date. Because Appellants have failed to present arguments particularly pointing out what limitations of independent claims 4

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and 12 are allegedly not found in the Examiner's Microsoft Word screenshots, we find Appellants have not established that the Examiner erred with respect to establishing a prima facie case of anticipation for claims 4 and 12. Moreover, we agree with the Examiner's reading of claims 4 and 12 on the Microsoft Word screenshots (*see* Ans. 4, 5-6). Therefore, we sustain the Examiner's rejection of independent claims 4 and 12 as being anticipated by the Microsoft Word screenshots for the same reasons argued by the Examiner in the Answer.

#### Dependent claims 5-8 and 13-16

We note that claims 5-8 depend from independent claim 4 and claims 13-16 depend from independent claim 12. Appellants have not presented any substantive arguments directed to the separate patentability of dependent claims 5-8 and 13-16. Therefore, we sustain the Examiner's rejection of these claims as being anticipated by the Microsoft Word screenshots. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2006).

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown the Examiner erred in rejecting claims 4-8 and 12-16 under 35 U.S.C. § 102(a) for anticipation.

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However, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting claims 1-3 and 9-11 under 35 U.S.C. § 102(a).

#### DECISION

The decision of the Examiner rejecting claims 4-8 and 12-16 under 35 U.S.C. § 102(a) for anticipation is affirmed.

The decision of the Examiner rejecting claims 1-3 and 9-11 under 35 U.S.C. § 102(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

#### AFFIRMED-IN-PART

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